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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,777	11/21/2003	Tina L. Grubb	98-70E	2884

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ROHM AND HAAS COMPANY  
PATENT DEPARTMENT  
100 INDEPENDENCE MALL WEST  
PHILADELPHIA, PA 19106-2399

EXAMINER
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FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,777

Applicant(s)

GRUBB ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,8-16 and 58-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,10-16 and 58-62 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Pending Claims***

Claims 1-3, 5, 6, 8-16, and 58-62 are pending.

### ***Previous Claim Objections***

1. The objection to claims 1-3, 5, 6, 8-16, and 58-62 has been overcome by amendment.
2. The objection to claim 4 has been rendered moot by the cancellation of claim 4.

### ***Previous Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of claims 1-3, 6, and 58 under 35 U.S.C. 103(a) as being unpatentable over Correll et al. (US Pat. No. 5,686,185) in view of Durand (US Pat. No. 5,334,631) has been overcome by amendment.

### ***Terminal Disclaimer***

5. The terminal disclaimer filed on January 17, 2005 has been reviewed and is NOT accepted. The application/patent being disclaimed has not been identified.

### ***Previous Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 5, 6, 58, and 60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 6 of U.S. Patent No. 6,677,032 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of Grubb et al. is fully encompassed by instant claims 1 & 6, wherein the core-shell resin of Grubb et al. falls within the broader "adduct" of instant claim 1.

- Claim 3 of Grubb et al. corresponds to the limitations of instant claims 5; and
- Claim 6 of Grubb et al. corresponds to the limitations of instant claims 58 and 60.

8. Claims 8, 10-16, 59, and 61-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9-14, and 16-20 of U.S. Patent No. 6,677,032 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 7 & 18 of Grubb et al. are fully encompassed by instant claim 8.

- Claim 9 of Grubb et al. corresponds to the limitations of instant claim 13;
- Claim 9 of Grubb et al. corresponds to the limitations of instant claim 11;
- Claim 10 of Grubb et al. corresponds to the limitations of instant claim 12;
- Claim 11 of Grubb et al. corresponds to the limitations of instant claim 14;
- Claims 12 & 19 of Grubb et al. correspond to the limitations of instant claim 16;
- Claims 13, 14 & 18 Grubb et al. correspond the limitations of instant claim 15;

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- Claim 16 of Grubb et al. correspond to the limitations of instant claim 10;
- Claims 17 & 20 of Grubb et al. correspond to the limitations of instant claims 59, 61 & 62.

9. Claims 58-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 9, 13, and 16 of U.S. Patent No. 6,346,292 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of Grubb et al. is fully encompassed by instant claims 58 and 60, wherein the core-shell resin of Grubb et al. falls within the broader "adduct" of instant claims 58 and 60.

Claims 6 and 13 of Grubb et al. are fully encompassed by instant claims 59 and 61, wherein the core-shell resin of Grubb et al. falls within the broader "adduct" of instant claims 59 and 61.

- Claims 9 and 16 of Grubb et al. correspond to the limitations of instant claim 62.

***Previous Allowable Subject Matter***

10. The indicated allowability of claims 4, 5, and 60 is withdrawn in view of the newly discovered reference(s) to Savin (US Pat. No. 5,677,367). Rejections based on the newly cited reference(s) follow.

11. The indicated allowability of claims 8, 10-16, 59, 61, and 62 stands for the reasons of record.

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***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 5, 6, 58, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Savin (US Pat. No. 5,677,367).

Regarding claims 1-3, 5, 6, 58, and 60, Savin discloses: (1) a chip resistant coating on high tensile steel (column 12, lines 60-61; column 13, lines 5-8) produced from a coating powder composition comprising (I) 100 weight parts of a resin chosen from: (i) a resin comprising A) an epoxy resin plus B) a polyhydroxyl functional cross-linker having a hydroxyl equivalent weight of from 200 to 500 (column 17, line 52 through column 18, line 19), and (ii) a resin comprising an adduct of from 75 to 95 wt%, based on the total weight of A) plus B), of an epoxy resin, and from 5 to 25 wt%, based on the total weight of A) plus B), of an elastomer component B) having a glass transition temperature of  $-30^{\circ}\text{C}$  or below, and (II) at least 150 weight parts of zinc powder (column 17, line 52 through column 18, line 19);

(2) wherein said epoxy resin is a bisphenol A epoxy resin (column 17, line 52 through column 18, line 19);

(3) wherein said elastomer component is carboxyl terminated butadiene/acrylonitrile rubber (*optional component; hence, the limitation is anticipated*);

(5) wherein said composition contains at least 200 weight parts of zinc powder (column 17, line 52 through column 18, line 19);

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(6) wherein the elastomer component has a glass transition temperature of  $-40^{\circ}\text{C}$  or below (*optional component; hence, the limitation is anticipated*);

(58) a method for coating a high-tensile steel surface to provide a chip resistant coating according to claim 1 comprising applying said coating composition to said surface, and heating said composition to form a coating (column 12, lines 1-62; column 13, lines 5-8); and

(60) a method for coating a high-tensile steel surface to provide a chip resistant coating according to claim 2 comprising applying said coating composition to said surface, and heating said composition to form a coating (column 12, lines 1-62; column 13, lines 5-8).

***Allowable Subject Matter***

14. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 8, 10-16, 59, 61, and 62 would be allowable if rewritten to overcome the ODP rejection(s) set forth in this Office action; or with a timely filed terminal disclaimer.

16. The following is a statement of reasons for the indication of allowable subject matter:

*Regarding claims 8-16, 59, 61, and 62, the combined teachings of Correll et al. and Durand fail to teach or suggest the dual coating set forth in claim 8, wherein the underlayer contains zinc powder and the top-layer is zinc free. Savin also fails to teach or suggest the claimed dual coating.*

***Response to Arguments***

17. Applicant's arguments with respect to claims 1-3, 6, and 58 have been considered but are moot in view of the new ground(s) of rejection.

18. Applicant's arguments filed January 17, 2004 have been fully considered but they are not persuasive.

Regarding the ODP rejections, Applicant argues that the rejection over the Grubb et al. references (6,677,032 and 6,346,292) is improper due to a restriction requirement in US SN 09/173,146. This application is the parent of the Grubb et al. references and the instant application. After a careful review of the restriction requirement, it has been determined that the Applicants' arguments are not completely accurate. The parent application was subject to a restriction requirement; however, the original claims did not feature an "adduct" material. The claims of the instant invention are similar to the original claims of the parent application; however, the scope is not exactly the same. Because the scope of the instant claims is different from the scope of the original claims of the parent application, an ODP rejection is appropriate.

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***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely  
Primary Examiner  
Art Unit 1712

April 1, 2005